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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/843,686	04/30/2001	Wolfgang Stripf	1454.1059-C	3446

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EXAMINER

BANANKHAH, MAJID A

ART UNIT	PAPER NUMBER
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2195

DATE MAILED: 08/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/843,686

Applicant(s)

STRIPF ET AL.

Examiner

Majid A. Banankhah

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 March 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 12-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 12-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>3/4/05</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This office action is in response to Request for Continued Examination filed on March 4, 2005. Claims 12-31 are considered for examination.

Response to Arguments

2. The issue of obviousness double patenting rejection between claims 12-31 of the present application and claims 1-12 of the '487' patent was raised in the office action issued on May 13, 2004. Applicant's representative in his response, filed on August 13, 2004, argued that there are substantial differences between the claims of the instance application and that of the '487' patent.

Upon further review by the Examiner, it is noted that the issue of obviousness double patenting rejection between claims of the present application and that of the '487', still exist and based on that conclusion, the Examiner in this office action provide a rejection detailing the obviousness type double patenting between claims of present application and that of '487' patent.

In the argument filed on August 12, 2004, applicant's representative alleges that there are substantial differences between the two sets of claim, but he does not provide any reasoning. In the instant case however, if Applicant's representative does not agree with examiner's opinion regarding this issue, he must provide a detailed argument addressing every claim limitation, as to why the claims 12-31 of the present application are not anticipated by claims 1-12 of the '487' patent. Mere allegation that the claims of the application are substantially different from claims of the '487' will not be considered to be persuasive in order to overcome the following rejection.

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Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 17 recites the limitation "software control block" in line 11. There is insufficient antecedent basis for this limitation in the claim. Correction is required.

Double Patenting

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 12-31 of the present application are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-12 of U.S. Patent No. 6,263,487 (hereinafter '487'). Although the conflicting claims are not identical, they are not patentably distinct from each other because of the following reasons.

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For example, in claim 12 of the present application, the first five lines of the claim are literally the preamble of the claim 1 of the Patent '487' respectively. The software function execution system recited in last paragraph of claim 12 in the present application is same as the software function block recited in claim 1, column 6, lines 29 of the Patent '487', except the detail of the function block is not in claim of the present application. The detail of the software function block (recited in claim 12 of the application) is in claim 13 (dependent from claim 12) of present application. In other words, claim 12 in the present application is anticipated by claim 1 in the Patent '487'. The claims limitations are not patentably distinct because the

It would have been obvious for one ordinary skill in the art at the time the invention was made to use fewer steps in order to expedite the process or method of claim 12 in the application.

The following table depicts a comparison between the elements of claim 12 in the present application and that of the '487' patent.

Claim 12 of present application	Citation in claim 1 of '487' patent
A Programmable controller	[5: 58]
to which software function block of a control program can be sent	[5:58-60]
the control program being processed by Pro. Cont. cyclically and/or with interrupt control during operation	[5:64-68]
the software function being designed to be loadable of being tied into the control program while it is running	[5: 60-63]
wherein the software function block are designed to be object-oriented to have software function block objects and designed to be loadable into the programmable controller over the internet and an internet communication interface of	[6:1-3], and [5: 59]

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the programmable controller	
and the programmable controller has a software function block execution system to tie in of the software function block objects and for processing the control program	[5:60-64]

Claim 13 of present application	
the software function block ... to process outputs	[6:1-7]
the bootstrap ... to the exec. engine object	[6:7-9]
a list of software... control program	[6:9-11]
a list of software... control program	[6:12-15]
at the start of ... when the cycle time is exceeded	[6:17-20]
update the inputs of the process image	[6:27]
process... the control program	[6:22-24]
ascertain changes ... to these inputs	[6:25-26]
update the output of the process image	[6:28-29]

As it is shown in the above table every element of claims 12 and 13 of the present invention has a corresponding element in claim 1 of the '487' patent, therefore, the claims of the present application are anticipated by claims of the '487' patent. The above table is an exemplary comparison between claims of the present application and that of the '487' patent. Other claim limitation in the application have a correspondent limitation in claims of the '487' patent, for

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example claim 14-16, recites the same limitation as claims 2-4 of the '487' patent. As another example claim 17 is anticipated by claim 5 of the '487' because:

Claim 17 of present application	Citation in claim 5 of '487' patent
programming unit for processing software function block of a control program	[6:41-42]
that can be sent to a programmable controller which process the control program cyclically and/or with interrupt control during control operation	[6:52-54]
The software function block objects being designed to be loadable and to be capable of being tied into the control program while it is running	[6:48-50]
the programming unit creates object-oriented software function blocks	[6:43-44]
The programming unit sends the software function blocks to the programmable controller over the internet and an internet communication interface of the programming unit	[6:45-47]
The software function blocks can be sent to the programming unit after the software control block is acted upon	Software control block does not have proper antecedent basis
The software function blocks being sent over the internet and the internet communication interface	[6:45-47]

Therefore, the obviousness double patenting rejection is proper.

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

How to Contact the Examiner:

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7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Maid Banankhah, whose telephone number is 571-272-3770. A voice mail service is also available at this number. The Examiner can normally be reached on Monday, and Wednesday - Friday, 7:00 AM - 3:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, An Meng-Ai who can be reached on 571-272-3756. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

All responses sent by U.S. Mail should be mailed to:

Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

PTO CENTRAL FAX NUMBER:
703-872-9306

- any inquiry of a general nature or relating to the status of this application should be directed to the TC 2100 Group receptionist: (703) 305-3900.

MAJID BANANKHAH
PRIMARY EXAMINER
